



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,155	12/10/2001	Gerd M. Muller	740105-81	7221

22204 7590 06/22/2004

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER

DABNEY, PHYLESHA LARVINIA

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,155

Applicant(s)

MULLER ET AL.

Examiner

Phylesha L Dabney

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
4a) Of the above claim(s) 12-60 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in reference to the election of species response filed 07 June 2004 in which claims 1-11 are pending.

Election/Restrictions

1. Applicant's election without traverse of Species I in Paper No. 4 is acknowledged. Upon allowability of claim 1, Species II-III are subject to possible rejoinder to the application.
2. Claims 26-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species IV-XII, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,999,632. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

Art Unit: 2643

limitations of the claims in the present application are covered by the scope of the claims in the patent with obvious wording variations; for example, Leysieffer et al (U.S. Patent No. 5,999,632) teaches a fixation element comprising a cylindrical housing part, surrounding a housing part of a microphone, including projecting elastic flange parts which is engageable against a side wall of the wall of the auditory canal which reads on the limitations presented in claims 1 of application (Application No. 10/010155) which teaches a fixation element comprising a cylindrical portion, surrounding a housing part of a microphone, including at least one elastic region of increased diameter adapted for insertion into a bore which crosses a wall of the auditory canal of a user, in addition to other examples comparable examples between the application and patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Leysieffer et al (U.S. Patent No. 5,999,632).

Regarding claim 1, Leysieffer teaches a fixation element (20) for an implantable microphone, wherein the fixation element comprises an essentially cylindrical portion (14) adapted to be inserted into a bore (fig. 1) which crosses a wall of the auditory canal of a user, said cylindrical portion, at least in an implanted state of the fixation element, surrounding an outer circumferential portion of a housing part of the microphone (11), which housing part is

Art Unit: 2643

provided with a sound receiving member (13), wherein said cylindrical portion includes at least one elastic region (23-25) of increased diameter, said elastic region contacting, in the implanted state of the fixation element, a wall of said bore and providing, by elastic restoring forces, for a friction which is sufficiently high to fix said cylindrical portion in at least one of the two axial directions of said bore (fig. 1).

Regarding claim 2, Leysieffer teaches the region of increased diameter is defined by at least one sealing member (23-25), which is adapted to sealingly contact the wall of the bore upon said cylindrical portion having been inserted into the bore.

Regarding claim 3, Leysieffer teaches the fixation element comprising at least two of such sealing members (23-25), which are axially spaced from each other.

Regarding claim 4, Leysieffer teaches the restoring forces of the at least one sealing member (23-25) are sufficient to prevent movement of the fixation element towards the side of the wall of the auditory canal remote from the skin of the auditory canal (fig. 1).

Regarding claim 5, Leysieffer teaches the outer circumference of the at least one sealing member (23-25), when disposed outside of said bore, is larger than the inner circumference of said bore (fig. 1).

Regarding claim 6, Leysieffer teaches the at least one sealing member is a sealing lip (23).

Regarding claim 7, Leysieffer teaches the at least one sealing lip (23) is adapted to fold in the direction of the side remote from the skin of the auditory canal when the cylindrical portion is inserted into the bore (fig. 1).

Art Unit: 2643

Regarding claim 8, Leysieffer teaches the at least one sealing member (23-25), at the side thereof facing the skin of the auditory canal, is tapered towards the skin of the auditory canal (fig. 1).

Regarding claim 9, Leysieffer teaches the fixation element, wherein a first one of said sealing members (23-25) is disposed at the end of the cylindrical portion (near 13), which, in the implanted state, faces the skin of the auditory canal.

Regarding claim 10, Leysieffer teaches the fixation element comprising a pair of sealing members (23-25) wherein a second one of said sealing members (24) is axially spaced from said first sealing member so as to contact, in the implanted state, the wall of the bore (fig. 1) near the end of the bore remote from the skin of the auditory canal.

Regarding claim 11, Leysieffer teaches the cylindrical portion is connected to a flange portion (24-25) of increased diameter, said flange portion, in the implanted state, contacting the side of the wall of the auditory canal remote from the skin of the auditory canal.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L Dabney whose telephone number is 703-306-5415. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 15, 2004

PLD


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600